

REMARKS

Claims 1 through 57 are pending in the application. Claims 1 through 23 have been withdrawn pursuant to a restriction requirement. Claims 38 through 57 are newly presented. The Examiner is respectfully requested to reconsider and withdraw the restriction requirement and the rejections in view of the amendments and remarks contained herein.

RESTRICTION REQUIREMENT

Applicant notes that the Examiner has not fully responded to Applicant's comments traversing the restriction requirement. Specifically, Applicant has noted that:

Section 806.05(a) of the MPEP provides "[a] combination is an organization of which a subcombination or element is a part." Section 806.05(d) of the MPEP, which was cited by the Office in the above-referenced Restriction Requirement, provides that two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately useable, are usually distinct from each other. Consequently, the "single combination" mentioned by the Office would appear to be the combination of Claims 1, 22 and 24. In other words, the "single combination" would include (3) bases, (3) carriages, (3) carriage elevation mechanisms and (1) locking mechanism. Applicant submits that the subject matter of Claims 1, 22 and 24 were not disclosed as being combine-able into the "single combination" and as such, there is no basis for the application of Section 806.05(d) of the MPEP. elements.

Accordingly, Applicant's traversal of the restriction requirement was not simply on the ground that "the inventions of the groups are similar and thus no undue burden to search and examine exists". Rather, Applicant specifically noted that the rationale for entering the restriction that was provided by the Office does not appear to be valid.

With regard to the "undue burden" aspect, Applicant notes that §808.02 of the MPEP requires that the examiner show that it is necessary to search for one

of the distinct subjects in places where no pertinent art to the other subjects exists. Applicant notes that each of the independent claims includes a carriage elevation mechanism having a plurality of threaded structures that are threadably engaged to an associated guide post. As such, Applicant respectfully submits that a thorough search for the subject matter of Claim 24 would include all places where pertinent art to the other subjects exists. Stated another way, a through search for a claim directed to a planer with a locking mechanism and a carriage elevation mechanism that includes a plurality of threaded structures that are threadably engaged to associated guide posts would necessarily include all places where pertinent art exists for a planer with an elevation mechanism that includes a plurality of threaded structures that are threadably engaged to associated guide posts.

In view of the above, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement so that Claims 1 through 23 may be considered on the merits.

NEWLY PRESENTED CLAIMS

Claims 38 through 57 are newly presented so as to provide the Applicant with a scope of protection commensurate with their contribution to the art. Applicant notes that these claims recite a plurality of threaded structures and a plurality of guide posts and describe the frictional engagement of the threaded structures and the guide posts as inhibiting movement of the carriage relative to the base. Accordingly, Applicant submits that the newly presented claims are

drawn to the grouping of claims (i.e., Group II) that the Office has characterized as including Claims 24 through 37.

REJECTION UNDER 35 U.S.C. § 112

Claims 24 through 37 stand rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. This rejection is respectfully traversed.

Applicant notes that the Office Action cites §2172.01 of the MPEP, a section that is directed to “unclaimed essential matter” and which cites *In re Mayhew*, 188 USPQ 356 (CCPA 1976) as support. Both §2172.01 and the *In re Mayhew* case, however, stand for the principle that all elements that are essential to the invention must be claimed, not for the proposition that the claim must include each of the components of a claimed invention that are necessary for its practical implementation. To this end, the Patent Laws are clear that a claim reciting a subcombination of elements from a large system or larger combination is permissible. This issue was addressed in *Carl Zeiss Stiftung v. Renishaw plc*, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991) and according to the Federal Circuit:

[i]t has long been held, and today we reaffirm, that it is entirely consistent with the claim definiteness requirement of the second paragraph of section 112, to present “subcombination” claims, drawn to only one aspect or combination of elements of an invention that has utility separate and apart from other aspects of the invention. As one of our predecessor courts stated, “it is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter,” as it is “entirely appropriate, and consistent with 112 to present claims to only [one] aspect”.

Id. at 1101.

In view of the above-remarks, Applicant submits that Claims 24 through 37 are complete and do not eliminate any elements that are essential to the invention. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 24 through 37 under 35 U.S.C. §112, second paragraph.

REJECTION UNDER 35 U.S.C. § 102

Claims 24, 25 and 28 through 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Liao (U.S. Pat. No. 6,089,286). This rejection is respectfully traversed.

Applicant notes that Claim 24 recites that “each of the nut assemblies being coupled to the carriage assembly and threadably engaged to the threaded adjustment portion of an associated one of the guide posts” and that “the nut assemblies are frictionally engaged to the threaded adjustment portions of the guide posts to inhibit rotation of the nut assemblies relative to the guide posts.”

The Liao reference, in contrast, does not teach or suggest this arrangement. Rather, the Liao reference utilizes a nut (73) which is threadably coupled to a tube (57) that is coupled for rotation with a hand wheel (56) as is shown in Figure 3. Tightening of the nut (73) moves the clamp plate (72) so that the posts (61 and 63) are urged into locking contact with the grooves (712) in the fixed clamp plates (71) as shown in Figure 4. Accordingly, “locking” of the height of the Liao device is effected through the locking of the tube that is connected to the hand wheel, not through frictional engagement of a nut assembly to a

threaded adjustment portion of a guide post. As such, Applicant submits that the Office has not presented a *prima facie* case of anticipation and respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 24, 25 and 28 through 30 under 35 U.S.C. §102(a).

REJECTION UNDER 35 U.S.C. § 103

Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Liao (U.S. Pat. No. 6,089,286) in view of Chang (U.S. Pat. No. 6,315,014). This rejection is respectfully traversed.

Applicant notes that the Chang reference utilizes a pair of threaded rods (22) that rotate relative to a tray frame (21) and that a chain element (23) is employed to rotate the rods (22). As the screw rods (62) in the Liao reference are maintained in a stationary condition, it appears that there can be no suggestion or motivation to combine the references as the Examiner has suggested since the proposed modification to the Liao device would render it unfit for its intended purpose. In this regard, a change in the height of the carriage (11) of the Liao device could not be effected if the screw rods (62) were permitted to rotate.

Accordingly, Applicant submits that the Examiner has not presented a *prima facie* case of obviousness and respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 26 and 27 under 35 U.S.C. §103(a).

ALLOWABLE SUBJECT MATTER

The Examiner states that claims 31 through 37 would be allowable if rewritten in independent form. Applicant has not amended claims 31 through 37 at this time, electing instead to pursue patentability of the base claim(s) from which these claims depend.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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